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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/598,506
Filing Date: June 21, 2000
Appellant(s): LAPCEVIC, THOMAS G.

Terence P. O'Brien
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08/17/2007 appealing from the Office action mailed 07/24/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,456,981	DEJAEGER ET AL	09-2002
6,553,404	STERN	04-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dejaeger (US 6,456,981) in view of Stern (US 6,553,404).

As per claims 1 and 8, Dejaeger teaches:

A computer-assisted method of establishing a brand presence in a facility, comprising:

accessing, by remote facility personnel, a central network computer housed in a central facility having a playlist that controls the playback of audio and video broadcasting within the facility (see Dejaeger column 1, line 23 – column 2, line 65; column 15, lines 5-16), the playlist comprising free entertainment and advertisement content (see column 21, lines 23-42) entering on the playlist, by remote facility personnel, identifiers of advertisement content related to the facility (see Dejaeger column 15, lines 5-16)

and the central computer network accessing the playlist entered by the remote facility personnel (see Dejaeger column 15, lines 5-17) but fails to teach and pushing to the remote facility via the Internet the playlist. Dejaeger does not teach an Internet connection to the central network computer from a remote facility. However, Stern teaches an Internet connection between an advertisement server and commercial sales outlets (see Stern column 10, lines 45-56). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Dejaeger would allow retailers to connect via the Internet to a central server, which would control the delivery of advertisements and entertainment content in the retailers' facilities, as taught by Stern. Using the Internet to connect to a central server would avoid the need to use a proprietary software.

As per claims 6, 12, 14 and 18, Dejaeger teaches:

The method of claim 1, but fails to teach further comprising pushing to the remote facility, via a medium selected from the group consisting of the Internet, satellite links, and combinations thereof, the playlist, which playlist includes advertisement related to the remote facility. However, Stern teaches pushing advertisements to a remote facility from a central server via the Internet and satellite link (see Stern column 10, lines 45-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Dejaeger would allow retailers to connect via the Internet or satellite link to a central server, which would control the delivery of advertisements in the retailers facilities, as taught by Stern. Using the Internet to connect to a central server would avoid the need to use a proprietary software.

As per claims 2, 9 and 15, Dejaeger teaches:

The method of claim 1, further comprising selecting, by remote facility personnel, a supplemental advertisement campaign (see column 1, lines 23-67; column 20, lines 15-54; column 10, lines 14-55).

As per claim 3, Dejaeger teaches:

The method of claim 2, wherein the supplemental advertisement campaign is selected from the group consisting of a print campaign, (see column 1, lines 23-67; column 24, lines 7-30). Dejaeger fails to teach an email and combinations thereof. However, Stern teaches a system that delivers advertisements to retail locations via the Internet (see Stern column 10, lines 57-63). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Dejaeger would transmit advertisements via the Internet or electronic mail to retail locations, as taught by Stern. This feature would use the Internet to delivering messages to customers which would avoid the need to use a proprietary software.

As per claims 4, 10 and 16, Dejaeger teaches:

The method of claim 1, further comprising reserving, by an organization affiliated with the remote facility, certain time slots for advertisements relating to the organization (see Dejaeger column 15, lines 4-16; column 12, lines 40-50). Dejaeger does not teach an Internet connection to a remote facility. However, Stern teaches an Internet connection between an advertisement server and commercial sales outlets (see Stern column 10, lines 45-56). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Dejaeger would allow

retailers to connect via the Internet to a central server, which would control the delivery of advertisements in the retailers' facilities, as taught by Stern. Using the Internet to connect to a central server would avoid the need to use a proprietary software.

As per claims 5, 11 and 17, Dejaeger teaches:

The method of claim 1, wherein entering on the playlist includes entering on the playlist, by remote facility personnel, identifiers of advertisements to be played in a portion of the remote facility (see column 15, lines 5-16). Dejaeger does not teach an Internet connection to a remote facility. However, Stern teaches an Internet connection between an advertisement server and commercial sales outlets (see Stern column 10, lines 45-56). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Dejaeger would allow retailers to connect via the Internet to a central server, which would control the delivery of advertisements in the retailers' facilities, as taught by Stern. Using the Internet to connect to a central server would avoid the need to use a proprietary software.

As per claims 7, 13 and 19, Dejaeger teaches:

The method of claim 1, but fails to teach further wherein the step of accessing, by remote facility personnel, the central network computer further comprises accessing, via the Internet, the central network computer. However, Stern teaches an Internet connection between an advertisement server and commercial sales outlets (see Stern column 10, lines 45-56). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Dejaeger would allow retailers to connect via the Internet to a central server, which would control the delivery

of advertisements in the retailers' facilities, as taught by Stern. Using the Internet to connect to a central server would avoid the need to use a proprietary software.

(10) Response to Argument

The Appellant argues in page 5 of the Brief that Dejaeger does not disclose "entertainment content" because according to the Appellant, Dejaeger teaches a playlist which consists of advertisement and online surveys and a person of ordinary skill in the art would not consider a "survey" to be entertainment. The Appellant also argues that "entertainment" is defined in a dictionary as "something diverting or engaging" and one of ordinary skill in the art would not consider a "survey" based upon said definition, to be "entertainment". The Examiner answers that Dejaeger discloses a system that displays to a customer a playlist comprising an "advertisement message" in conjunction (*i.e.* concurrently) with an a "retail survey" (see Dejaeger col 15, lines 40-45), where said "retail survey" can be construed to be "free entertainment content" as said "survey" is based upon questions of particular interest to a customer (see Dejaeger col 5, lines 50-55) and where said customer is remunerated for responding to said "survey" (see Dejaeger col 9, lines 5-15). Furthermore, the Examiner did a 103 rejection to reject Apellant's claims and Stern teaches that it is old and well known in the promotion art to display a playlist to customers of a commercial outlets, where said playlist comprises entertainment and advertisement content (see Stern col 3, lines 1-20; col 3, lines 55-65; col 4, lines 8-27). The Examiner can also respond to Appellant's argument by saying that what is considered "entertainment" for some people is not "entertainment" for other, so for some people, including the Examiner, responding to a "survey" would be

considered as “entertainment”, and also mentioning, that nowhere in Appellant's specification or Appellant’s provided dictionary definition of “entertainment” is recited or disclosed that responding to a “survey” is not considered “entertainment". However, the Examiner wants to point out that in Appellant’s claimed invention, changing the “entertainment content” would not cause the change of the “advertisement content" or vice versa, as the Appellant’s claims simply disclose displaying a playlist, where “advertisement content” would be displayed concurrently with “entertainment content”. Therefore, simply finding a prior art that shows a playlist that display “advertisement content” displayed concurrently with “something else” where said "something else” can be construed to be ”entertainment content” would read Appellant’s claims as the only thing that links said “advertisement content” to said "entertainment content" is that said contents have to be displayed concurrently. Furthermore, using Appellant’s dictionary definition of “entertainment”, where “entertainment” is defined as “something diverting or engaging”, Dejaeger “survey” would also be considered something diverting or engaging as said “survey” presented to a customer is based upon questions of particular interest to said customer and where said survey would occupy the attention or effort of said customer (*i.e.* “engaging”; see Dejaeger col 5, lines 50-55). Therefore, contrary to Appellant's argument, displaying to a customer a playlist comprising advertisement and entertainment is old and well known, as taught by Dejaeger and Stern.

The Appellant argues in page 6 of the Brief that Dejaeger does not teach the limitation of “entering on the playlist, by facility personnel, identifier of advertisements

related to the facility" because according to the Appellant, Dejaeger does not teach the step of establishing a brand presence in a facility. Furthermore, the Appellant argues that the only thing Dejaeger teaches that the retailer can configure, is whether a predetermined number of advertisements are played or whether advertisements are played during the entire checkout operation. The Examiner answers that Appellant's definition of establishing a brand presence in a facility is disclosed in Appellant's specification where it recites that "for example, if the facilities are health clubs, the facilities can establish a strong brand presence to its members and potential members for such services and goods as nutrition supplements, massage, personal training, etc. The facilities can establish a strong brand presence by generating advertisements for the facilities" (see Appellant's specification page 23, lines 15-23). Therefore, according to Appellant's specification "establishing a brand presence in a facility" simply means displaying advertisements to customers of a facility, where said advertisements are related to products or services offered by said facility. Dejaeger teaches targeting advertisements to customers of a retailer (*i.e.* facility), where said advertisements or promotions are for items sold by said retailer, services offered by said retailer or periodic sales or discounts offered by said retailer (see Dejaeger col 7, lines 7, lines 22-30). Furthermore, Dejaeger teaches that retailer may configure the retail system 10 (see figure 1) to determine which advertisements are to be displayed on the self service checkout terminal (see col 15, lines 5-15). Therefore, contrary to Appellant's argument, Dejaeger teaches "establishing a brand presence in a facility" as Dejaeger displays advertisements to customers of a retailer, where said advertisements are related to

products and/or service sold or offered by said retailer (*i.e.* brand presence) and also teaches that said retailer (*i.e.* facility personnel) controls the advertisements related to said retailer that would be presented to customers of said facility, as Dejaeger allows a retailer to configure the retail system 10 to determine how and which advertisements (*i.e.* "periodic sales or discounts" see col 7, lines 22-27) would be displayed to a customer in said facility. Therefore, contrary to Appellant's argument, Dejaeger teaches the limitation "establishing a brand presence in a facility" and also teaches that retailers can configure the advertisements to be displayed on said retailer facility (*i.e.* "periodic sales or discounts").

The Appellant argues that Dejaeger does not teach a "central network computer" and a "remote facility" and that the facility personnel access the computer having a playlist that controls the playback of audio and video broadcasting within the facility via the Internet and that the playlist which includes advertisements related to the facility is pushed to the facility. The Appellant further argues that the Examiner attempt to buttress the teaching of Dejaeger by applying the Stern reference, however, the Appellant argues that nowhere does the Examiner attempts to justify this combination. The Examiner answer that Dejaeger teaches an external network system 56 (see figure 1) that may be located in a centralized office associated with the retailer and provides a centralized source for electronic updating the various databases associated with the central server 42 (see Dejaeger figure 1) at each of the retailer's stores. Stern teaches a retailer central server 160 (see Stern figure 1b) connected to an external network computer NMC 110 (see Stern figure 1b), where said external network computer 110

provides a centralized source for electronic updating of the various database (see Stern col 28, lines 44-55), where the retailer outlet (See Stern figure 1a, item 135) connects to the central server 110 (see figure 1A) via the Internet (see col 10, lines 45-60) and where the commercial entity (See figure 1a, item 130) communicates with the NMC server so said server updates the products of said commercial entity (see Stern col 27, lines 20-30). Therefore, Dejaeger networks computer 56 (see Dejaeger figure 1) is equivalent to Stern central computer NMC (see Stern figure 1a item 110) and Dejaeger's central server 42 (see Dejaeger figure 1) is equivalent to Stern's commercial outlet 130 (see Stern figure 1a) central server 160 (see Stern figure 1b item 160). Furthermore, Stern and Dejaeger teach that their system is for the distribution of entertainment and advertisement content in commercial sales outlets such as department stores, retail outlet (see Stern col 3, lines 50-55; see Dejeager col 1, lines 30-35). Furthermore, Dejaeger teaches that retailers configure the advertisement to display in a retail terminal where said advertisements are related to products and/or services sold or periodic sales or discounts offered by said retailer (See Dejaeger col 7, lines 20-30 and col 15, lines 5-15). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made to known that Dejaeger's central server computer 56 would function as the Stern's central server NMC 110 where retailers would connect to said remote computer (*i.e.* Stern's NMC 110 or Dejaeger server 56) via the Internet to obtain updated data, where said data would configure the advertisements and promotions that would be delivered to the Dejaeger's central server 42 (see Dejaeger figure 1, item 42) and where said advertisements would be related to

product sold or periodic discounts offered by said retailers. Dejaeger would be motivated to be combined with Stern in order to have a centralize office to associated with the retailer (see Stern NMC 110 figure 1a; Dejaeger item 56 figure 1) that would control the delivery of advertisements and promotions to different retailer and all done via the Internet, avoiding the use of a proprietary software to do said communication. Therefore, contrary to Appellant's argument, Dejaeger and Stern teach Appellant's claimed invention.

The Appellant further argues in page 7 of the Brief that in fact the combination of Dejaeger and Stern would necessarily result in providing entertainment content to shoppers at a check-out terminal in a grocery or department store and that according to the Appellant, Dejaeger teaches the undesirability of this, because according to the Appellant, Dejaeger teaches that the number of survey questions would damage throughput through the checkout terminal, then according to the Appellant, it is not difficult to image, the damage entertainment content could do. The Examiner answers that the Appellant is arguing about limitation not stated in the claims. Appellant's claims simply recites "having a playlist that controls the playback of audio and video broadcasting within the remote facility, the playlist comprising free entertainment and advertisement content". Dejaeger teaches displaying to users in a checkout terminal a playlist comprising retail survey (*i.e.* "entertainment") and an advertising message (see col 15, lines 40-45) and Stern teaches that it is old and well known in the promotion art to display to a user of a retail establishment a playlist comprising entertainment and advertisement content (see Stern col 5, lines 15-20). Therefore, contrary to Appellant's

argument, Dejaeger and Stern teach Appellant's claimed invention. Furthermore, the fact that Dejaeger retail survey needs to be altered based on usage of the self service terminal (see Dejaeger col 11, lines 40-50) would not change the fact that Dejaeger would still be displaying a playlist comprising advertisement and entertainment content, as said retail survey (*i.e.* "entertainment content") would still be displayed concurrently to said advertisement content but in an altered version and furthermore, Appellant's claims do not mention anything about a time constraint limitation. Therefore, contrary to Appellant's argument, Dejaeger and Stern teach Appellant's claimed invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/DANIEL LASTRA/

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